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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,678	10/27/2000	Ryosuke Taniguchi	400906	5239

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EXAMINER

BUDD, MARK OSBORNE

ART UNIT PAPER NUMBER

2834

DATE MAILED: 05/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

697 678

Applicant(s)

Taniguchi et al

Examiner

M. Budd

Group Art Unit

2834

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4-23-02.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12, 14-20 and 26 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-12, 14-20 and 26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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Claims 1-12, 14-20 and 26 are rejected under 35 U.S.C. 103 as unpatentable over Taniguchi (448) for the specific reasons set forth in paper no. 11 (-23-02). Regarding applicants arguments it is noted that a device is blind as to how it was manufactured, and that manufacturing steps are not considered limitations in an apparatus claim. Thus Shink-fit cannot distinguish from the prior art structure. Applicants contend that Shink-fit can notes structure. The examiner disagrees. The identical structure could be produced by a force-fit, aor slightly bending the laminations inserting the ends into the opening and pressing the laminations into an unbent (pre loaded) condition. The presence or absence of an additional spacer is also not indicative of how the device was assembled.

Applicant contends that the omission of an element (preload spacers) in Taniguchi with the consequent loss of function wold not have been obvious to one of ordinary skill in the art. First there need not be an explicit teaching in Taniguchi since the basis permission is settled in case law. Second as noted above, shrink fit is not treated as a limitation in these apparatus claims. Third, the benefits of shrink-fitting are not unexpected. As described in the prior art preloading is known to increase the output of a magnetostrictive device) up to its buckling point). Thus any preload would be expected to be beneficial. Eliminating a specific preload means would not mean abandonment of providing a preload for its known benefits. Thus, e.g. a "force fit" could be used. Note that except for "desired function" applicants spacer (claim 26) and the end elements of Taniguchi are structurally the same.

Taniguchi (916) is withdrawn as a reference for the reasons pointed out by applicant.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Budd/ds

05/08/02

MARK J. BUDD
PRIMARY EXAMINER
ART UNIT 212